UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,541	05/29/2001	Tsunekazu Ishihara	3917-4	4238

27562	7590	09/06/2005

NIXON & VANDERHYE, P.C.
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER
COBURN, CORBETT B

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _18 August 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,7-16,18-46,48,49 and 51-72_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,7-16,18-46,48,49 and 51-72_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _29 May 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _6/15/05, 8/3/05_

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Information Disclosure Statement

1.   The information disclosure statement filed 15 June 2005 and (again) on 3 August 2005

fail to comply with 37 CFR 1.97(d) because they lack a statement as specified in 37 CFR 1.97(e).

They have been placed in the application file, but the information referred to therein has not been

considered.

2.   The information disclosure statement filed 15 June 2005 and (again) on 3 August 2005

fail to comply with 37 CFR 1.98(a)(3) because they do not include a concise explanation of the

relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most

knowledgeable about the content of the information, of each document listed that is not in the

English language. It has been placed in the application file, but the information referred to

therein has not been considered.

Allowable Subject Matter

3.   The indicated allowability of claims 1, 7-16, 18-43, 51-57, 61 & 62 is withdrawn in view

of the newly discovered reference(s) to Kaneko (US patent Number 5,331,141) and Bromley (US

Patent Number 5,026,058). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claim 1, 9, 13, 15, 21, 25-32, 35, 39-46, 48, 52-54, 63, 65 & 68 are rejected under 35

U.S.C. 103(a) as being unpatentable over Kaneko (US patent Number 5,331,141) in view of

Bromley (US Patent Number 5,026,058).

> **Claims 1, 13, 25, 28, 29, 31, 32, 39, 40, 44, 45, 48, 54, 63, 65:** Kaneko teaches a game
>
> system having a plurality of cards (4). The cards include recorded data (Col 15, 13-16)
>
> for use in a card game. There is a game information storage medium (8) storing a game
>
> program relating to game card figures in RAM and ROM. The game information storage
>
> medium (8) is readily removable from the processing system and contains processing
>
> circuitry (memory). (Fig 13) There is a processing system (5) for receiving therein the
>
> game information storage medium. The game machine executes an image display game
>
> program that is stored in the memory section. (Col 13, 47 - Col 14, 3) The cards store,
>
> for each character depicted, identification data and characteristic data relating to a
>
> characteristic of an associated character (Col 15, 13-16) and for causing a change to a
>
> graphics image involving a displayed associated character dependent on the progress of
>
> the image-displaying game. (Col 13, 47 - Col 14, 3) The card contains data concerning
>
> the strength of the character and any skills or defenses. The data is read by the processor
>
> and used to determine success and failure of attempted attacks and defenses. The game
>
> determines the success of the batting (i.e., attacking) team and the fielding (i.e.,
>
> defending) team based on the player statistics read from the cards. (Fig 16) The game
>
> system has a game piece reader (10) for reading the identification and characteristic data
>
> from the card. The processing system processes the supplied identification and
>
> characteristic data from one or more game cards (a first and second card) in accordance

with the game program stored in a second game program memory section. (Fig 16)

There is a connector connecting the card reader to the game machine having a processing

system for executing a game program. (Fig 13)

Kaneko fails to teach that the cards visually portray a figure. This is extremely

well known to the art. Bromley teaches a similar game that includes a card (88) that

visually portrays a figure (Fig 9A) as well as text explaining the character (i.e., player

stats, Fig 9B). Baseball cards have traditionally portrayed an image of the player. This

adds interest to collecting the cards. It would have been obvious to have modified

Kaneko in view of Bromley to have the cards visually portray a figure in order to add

interest to collecting the cards.

Kaneko teaches that the characters are displayed during the course of game play.

(Col 13, 47 - Col 14, 3) While this almost certainly suggests animation of the images and

causing a change in the video image involving an animated and displayed associated

character dependent on the progress of the game, this is not explicitly disclosed.

Bromley teaches animation of the images and causing a change in the video image

involving an animated and displayed associated character dependent on the progress of

the game – the movement of the ball and players on the field is depicted throughout the

course of the game. (Fig 7) Animation is the essence of the video game. Animation

adds interest to a video game. It would have been obvious to one of ordinary skill in the

art at the time of the invention to have modified Kaneko in view of Bromley to cause a

change in the video image involving an animated and displayed associated character

dependent on the progress of the game in order to add interest to the game.

Claims 9, 35: Bromley teaches including text on the card explaining an individual

feature of the character. (Fig 9B) Kaneko teaches displaying text read from the card on

the screen. (Col 13, 53-58)

Claim 15: Kaneko teaches that the characteristic data includes ability data related to the

character and the processing system generates a display state of the character in the game

based on the ability data read by the external information reading circuit. The character's

position on the screen is based on ability data. For instance, a character's ability to be a

pitcher would cause him to be displayed on the pitcher's mound. A character's ability to

bat left-handed would cause the player to be displayed on the appropriate side of the plate

during batting.

Claims 26, 41, 43, 52 & 68: Kaneko teaches a groove (11) for receiving at least a

portion of the card and reading the card. Kaneko teaches that both the barcode reader

(11) and game cartridge (8) are removable. (Col 17, 35-40) But Kaneko does not teach

putting the groove and card reader on the removable memory cartridge. The reader and

the cartridge are electrically connected and the game will not function unless both are

present. Combining the two devices in a single housing would free up a communications

port and would ensure that the two devices stayed together – thus preventing the system

from becoming unusable because one or the other component was lost. This would

greatly enhance user convenience. It would have been obvious to one of ordinary skill

in the art at the time of the invention to have modified Kaneko to put the groove and card

reader on the removable memory cartridge in order to enhance user convenience.

Claim 27: Kaneko and Bromley both teach cards that store a plurality of kinds of

characteristic data (i.e., power, offensive & defensive data) on an identification-code -by-

identification-code basis – i.e., each is recorded on a barcode. Bromley has a computer

(Fig 11) with semiconductor solid-state memory for storing characteristic data. The

computer is in a case (Fig 1) and is integrally formed with the card reader.

Claims 30, 46, 53: Bromley shows a hand-held device including a display.

Claim 42: Kaneko teaches a game machine that executes an image display game

program that is stored in one memory section. The cards store, for each character

depicted, identification data and characteristic data relating to a characteristic of an

associated character. The game system has a game piece reader (11) for reading the

identification and characteristic data from the card. The processing system processes the

supplied identification and characteristic data in accordance with the game program

stored in a second game program memory section. (Fig 13)

6.   Claims 8, 10, 14, 34, 36, 51, 56, 57, 64, 66, 69 & 72 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Kaneko and Bromley as applied to claim 1, 13, 28 or 51 in view of

Yokoyama.

Claims 8, 14, 20, 34, 56: Kaneko and Bromley teach the invention substantially as

claimed, but do not teach providing appropriate sound data via barcodes and generating

sounds based on this data. Sounds are an integral part of video games. They add

excitement to the game. Yokoyama teaches providing appropriate sound data via

barcodes and generating sounds based on this data. (Fig 25) It would have been obvious

to one of ordinary skill in the art at the time of the invention to have modified Kaneko

and Bromley in view of Yokoyama to provide appropriate sound data via barcodes and generate sounds based on this data in order to add excitement to the game.

Claims 10, 22, 36, 51, 64, 66: Both Kaneko and Bromley teach a card reader that is an optical reader for optically reading the identification and characteristic data corresponding to the character visually depicted on the card. They fail to teach that the barcode is a two-dimensional array of dots. Yokoyama teaches a game card that records the identification and characteristic data may be in the form of a two-dimensional array of dots. (Fig 30) A two-dimensional array of dots is a well-known equivalent to a barcode.

Claim 57: Kaneko and Bromley teach the invention substantially as claimed, but do not teach that the processing system, when not supplied with the identification data and characteristic data by the card reader (11) executes a process on the basis of only the game program stored in memory. Yokoyama teaches that the processing system, when not supplied with the identification data and characteristic data by the card reader executes a process on the basis of only the game program stored in memory. This allows the implementation of a one-player mode. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko and Bromley in view of Yokoyama to have the processing system, when not supplied with the identification data and characteristic data by the card reader execute a process on the basis of only the game program stored in memory in order to implement a one-player mode.

Claim 69, 72: Yokoyama teaches determining whether a sufficient number of cards have been read to execute the game. (I.e., in one player or two player modes.) In order to make this determination, the game must base the execution of the game on total amount

data. This data is derived from information read from the cards – i.e., the number and

type of cards read.

7.   Claims, 11, 12, 16, 19-24, 37, 38, 60, 67, 70 & 71 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Kaneko and Bromley as applied to claim 1 or 28 and further in view of

Eskildsen (US Patent Number 5,962,839).

Claims 11, 12, 16, 23, 24, 37 & 38: Kaneko and Bromley teach the invention

substantially as claimed, but do not teach a magnetic card. Eskildsen teaches that the

card data may be recorded on non-volatile memory and read therefrom via a magnetic

reader. (Col 1, 46-48) In this embodiment, the characteristic data includes ability data

recognizably printed on the game card (see Bromley, Figs 9A & B) and hidden data not

visibly printed on the game card. The picture with identifying information is

recognizably printed on the game card while the data stored on the magnetic medium is

not visibly printed. It is well known that magnetic cards and barcodes are equivalent. It

would have been obvious to one of ordinary skill in the art at the time of the invention to

have modified Kaneko and Bromley in view of Eskildsen to make use of a magnetic card

in order to achieve an equivalent function with an equivalent structure.

Claims 18, 60: Eskildsen teaches storing additional data that includes a mini-game

program that may be added to the game based on the game program stored in the game

information medium. Each of Eskildsen's barcode represents a mini-game program.

Claims 19, 20: Eskildsen teaches including sound data on the bar codes.

Claim 21: Both Kaneko and Bromley teach an identification code (barcode) on the card. Bromley's card identifies the visually portrayed character. The data stored on the card is, in and of itself, "data for determining the amount of data recorded".

Claim 22: Both Kaneko and Bromley teach a card reader that is an optical reader for optically reading the identification and characteristic data corresponding to the character visually depicted on the card. They fail to teach that the barcode is a two-dimensional array of dots. A two-dimensional array of dots is a well-known equivalent to a barcode.

Claim 67: Kaneko and Bromley teach the invention substantially as claimed, but do not teach that the recoded data (i.e., the barcode) embodies program instructions that are executed by the processing system. Kaneko teaches that any game may be implemented with the disclosed system. (Col 14, 60-63) Eskildsen teaches a game in which the recoded data (i.e., the barcode) embodies program instructions that are executed by the processing system. This greatly increases the flexibility of the game because it allows players to determine the order in which to execute commands. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kaneko and Bromley in view of Eskildsen to have the recoded data (i.e., the barcode) embody program instructions that are executed by the processing system in order to increase the flexibility of the system by allowing players to determine the order in which to execute commands.

Claims 70, 71: Eskildsen teaches that the barcodes may be read in any order desired by the player. Thus the order may be rearranged.

8.   Claims 7, 33, 49 & 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kaneko and Bromley as applied to claim 1, 25, 28, 44 or 54 above, and further in view of

Garfield (US Patent Number 5,662,332).

> **Claims 7, 33, 49, 55:** Kaneko and Bromley teach a game machine using cards to play a
>
> game associated with a game program. Bromley teaches that the game cards baseball
>
> cards. (Col 5, 6-16) Baseball cards are collecting cards, but Bromley does not explicitly
>
> teach a trading card game with characters of differing rarity values. Garfield teaches a
>
> trading card game including a figure of a character differing in rarity value. (Col 7, 56-
>
> 58) Garfield teaches having cards of differing rarity values increases the value of the
>
> game components (rare cards) and encourages players to trade and collect game cards.
>
> (Col 7, 12-20) It would have been obvious to one of ordinary skill in the art at the time
>
> of the invention to have modified Bromley's card game by including trading cards of
>
> differing in rarity value as suggested by Garfield in order to increase the value of the
>
> game components (rare cards) and encourages players to trade and collect game cards.

9.   Claims 61 & 62 rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko and

Bromley in view of Yamada (US Patent Number 6,398,651).

> **Claim 61:** As discussed in detail above, Kaneko and Bromley teach the invention
>
> substantially as claimed, but do not teach the game card being machine-readably recorded
>
> with image data for displaying the image of a character on the display screen. It is well
>
> within the capability of Kaneko to store such data. In fact, Kaneko discloses use of such
>
> data, but does not discuss how it is loaded into the machine. (Col 13, 47-57) Yamada
>
> teaches storing such information on cards and displaying the image data read from the

card on the screen. This provides a convenient method of supplying the data required by

Kaneko's disclosure. It would have been obvious to one of ordinary skill in the art at the

time of the invention to have machine-readably stored image information on cards and

displaying the image data read from the card on the screen in order to supply the data

required to implement Kaneko's disclosure.

Claim 62: Kaneko teaches a game card that records the identification and characteristic

data as a barcode. A barcode is the equivalent of an array of dots distributed within

blocks.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Reference Name	Reference Number	Applicability
Hara	EP 0567687	Barcode game
Seigel et al.	US 2003/0134679	Barcode game

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Corbett B. Coburn
Examiner
Art Unit 3714